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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/625,149

07/23/2003

H. Downman McCarty II

HHT-

8274

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7590

04/27/2010

BROOKE SCHUMM III

Daneker, McIntire, Schumm, Prince, Goldstein et al

ONE NORTH CHARLES STREET

SUITE 2450

BALTIMORE, MD 21201

EXAMINER

FLORES SANCHEZ, OMAR

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

04/27/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/625,149	Applicant(s) MCCARTY ET AL.	
	Examiner Omar Flores-Sánchez	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 143-163 is/are pending in the application.
- 4a) Of the above claim(s) 152, 153 and 159-163 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 143-151 and 154-158 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on 01/21/10.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 143, 144, 146, 147, 148, 150, 151 and 156 are rejected under 35 U.S.C. 102(b) as being anticipated by Zetterman (1,409,638).

Zetterman discloses the invention including:

- Claim 143, 146, 148 and 151; a shaft 10 having a striking end (see Fig. 5) and a working end 11; and a shaped polymeric material 13 reinforced by a material selected from the group of fiber or mineral(see col. 3, line 24) to be impacted disposed *immediately* adjacent (see Fig. 4 where the polymeric material 13 cover the end and there is nothing between both element to be sufficient to be consider immediately adjacent) to said striking end to avoid direct metal-to-metal contact *and in order to eliminate any damage to the shaped reinforced polymeric material from any gap* (the device is capable of performing the intended use recitation by the user controlling the striking force to avoid damage), said shaped polymeric material having a striking end area 17 of said polymeric material adjacent to said striking end and an impact end area (14 and 21)

to be impacted roughly opposite said striking end area, said shaped polymeric material being of sufficient cross-sectional area for transmitting impact upon the impact end area, of appropriate thickness through said cross-sectional area, and of sufficient modulus to enable greater than sixty-seven per cent impact effectiveness compared to a similar impact tool without said polymeric material disposed adjacent to said striking end (the head of Zetterman is capable of performing the intended use of transmitting impact to enable greater than sixty-seven per cent impact effectiveness (see col. 2, lines 93-95, where the cap is able to insure the effect of the blow would be received by the platform 14).

- Claim 144 and 147; said shaped polymeric material being selected to have the further characteristic of redistributing the sound frequency on impact by a driving force on said impact tool to lower frequency ranges than said impact tool without said shaped polymeric material so that resulting sound and vibration is of lower dB, and less harmful frequency ranges to humans (the head (see col. 1, lines 45-47) of Zetterman is capable of lowering the frequency ranges).
- Claim 150; the shaped polymeric material of Zetterman being shaped so that no edge or surface is presented having a radius of curvature of less than .02 inches.
- Claim 156; the shaped polymeric material being shaped to extend beyond the cross-sectional area of said impact end area (see Fig. 4).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 145 and 149 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zetterman (1,409,638) in view of Smith (4,497,355).

Zetterman discloses the invention substantially as claimed except for an included angle from the standard 65-70 degree. However, Smith teaches the use of an included angle of 65 degree for the purpose of assuring the effectiveness of the chisel and prolonging its life. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device of Zetterman by providing the included angle of 65 degree as taught by Smith in order to obtain a device that assures the effectiveness of the chisel and prolong its life.

6. Claims 154-155 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zetterman (1,409,638).

Zetterman discloses the invention substantially as claimed except for polyamide or fiber-reinforced nylon. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device of Zetterman with polyamide or fiber-reinforced nylon for the purpose of having a stronger material, since it has been held to be within

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the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

7. Claims 157-158 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zetterman (1,409,638) in view of Vasudeva (6,076,431).

Zetterman discloses the invention substantially as claimed except for a grip and flange. However, Vasudeva teaches the use of a grip and flange for the purpose of having a better support and protection for the user's hand. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device of Zetterman by providing the grip and flange as taught by Vasudeva in order to obtain a device that have a better support and protection for the user's hand.

Response to Arguments

8. Applicant's arguments have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., no air gap) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The term "immediately adjacent" doesn't mean the lack of any gap between elements. Also, e.g. see Fig. 4, where the interior wall of the material is immediately adjacent to the boundary of the end. There is no evidence on the prior art that the gap by themselves would cause damage to the polymeric material.

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Applicant argues that the claims have been restricted to a device that has an impact effectiveness specification for metal or stone, however, the argument are not accurate because the claims cited a material to enable to transmit impact to the end with greater impact effectiveness. Nothing in the claims links the impact effectiveness specification with cutting metal or stone. The citation of metal or stone in claims doesn't provide any relation between the impact effectiveness specification and metal or stone.

Also, the prior arts are capable of being struck on said impact end area at least 250 times without deformation of said shaped polymeric material by regulating the amount of force.

9. The declaration filed on 01/21/10 under 37 CFR 1.131 has been considered but is ineffective to overcome the scope of the declaration or affidavit is not commensurate with the scope of the claims reference. The test are not accurate since the specific material cited by the prior art was not used. The test relies on greater forces for cutting stone but the parameters of forces and the stone are not disclosed and neither in claims.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Flores-Sánchez whose telephone number is 571-272-4507. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/O. F./

Examiner, Art Unit 3724

4/24/2010

/Boyer D. Ashley/

Supervisory Patent Examiner, Art Unit 3724